

ESTTA Tracking number: **ESTTA506605**

Filing date: **11/20/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	IdenTrust, Inc.
Granted to Date of previous extension	11/21/2012
Address	55 Hawthorne Street Suite 400 San Francisco, CA 94105 UNITED STATES

Attorney information	Stephen J. Huggins SNR Denton US LLP P. O. Box 061080 Chicago, IL 60606-1080 UNITED STATES stephen.huggins@snrdenton.com, brian.mcginley@snrdenton.com, anita.hansen@snrdenton.com, TTAB@snrdenton.com
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### Applicant Information

Application No	85594287	Publication date	07/24/2012
Opposition Filing Date	11/20/2012	Opposition Period Ends	11/21/2012
Applicant	MorphoTrust USA, Inc. 296 Concord Road, Third Floor Billerica, MA 01821 UNITED STATES		

### Goods/Services Affected by Opposition


Class 045. All goods and services in the class are opposed, namely: Identification verification services, namely, the issuance and authentication of identification cards, driver's licenses, hunting and fishing licenses, and other identity documents
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3506532	Application Date	02/13/2006
Registration Date	09/23/2008	Foreign Priority Date	NONE
Word Mark	IDENTRUST		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2006/03/31 First Use In Commerce: 2006/03/31 Computer programs for issuing digital certificates for authenticating users for access to online systems for use in an electronic transaction or communication; smart cards containing programming, namely, digital certificates, used to verify the identity of parties to an electronic transaction</p> <p>Class 042. First use: First Use: 2006/03/31 First Use In Commerce: 2006/03/31 Digital certification and security services, namely, providing encryption of data; computer consultation in the field of network security and authentication of digital signatures in an electronic transaction or communication; design of computer hardware, software, and specifications used for network security and authentication of digital signatures and identities in an electronic transaction or communication; technical support services, namely, troubleshooting of computer hardware and software problems via telephone, email and in person</p> <p>Class 045. First use: First Use: 2006/03/31 First Use In Commerce: 2006/03/31 Issuance and validation of digital certificates providing authentication of the source of a digital communication, authentication of identity and/or of a digital signature in an electronic transaction or communication, authentication of identity for physical or logical access control</p>

Attachments	78813698#TMSN.jpeg ( 1 page )( bytes ) IDENTOGO 85594287-Notice of opposition.pdf ( 7 pages )(99896 bytes ) Exhibit A.pdf ( 1 page )(144068 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/stephen j huggins/
Name	Stephen J. Huggins
Date	11/20/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of	)	
Application Serial No. 85/594,287	)	
Published in the July 24, 2012	)	
<i>Official Gazette</i>	)	
	)	
<b>IDENTRUST, INC.</b>	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
<b>MORPHOTRUST USA, INC.,</b>	)	
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

IdenTrust, Inc. (hereinafter “Opposer” or “IdenTrust”), a Delaware corporation having its principal place of business at 55 Hawthorne Street Suite 400 San Francisco, California 94105, believes that it will be damaged by registration of the mark shown in Application Serial No. 85/594,287 and hereby opposes registration of same under § 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

On April 11, 2012, Applicant MorphoTrust USA, Inc. (“Applicant”) filed an intent-to-use application, Serial No. 85/594,287, for the mark IDENTOGO. The United States Patent and Trademark Office (“USPTO”) published the application for opposition in the *Official Gazette* on July 24, 2012, allowing time to oppose said application up to and including August 23, 2012. On August 21, 2012, IdenTrust filed a Request for Extension of Time to Oppose until September 22, 2012. The Trademark Trial and Appeal Board (“TTAB”) granted IdenTrust’s Request. On September 20, 2012, IdenTrust filed a Request for Extension of Time to Oppose until November

21, 2012. The TTAB granted IdenTrust's Request. Accordingly, IdenTrust has timely filed this Notice of Opposition.

The grounds for opposition are as follows:

**The IDENTRUST Mark**

1. IdenTrust is a long-established and well-known provider of identity authentication software and services in the U.S.

2. IdenTrust owns U.S. Registration No. 3,506,532 for the mark IDENTRUST for: "Computer programs for issuing digital certificates for authenticating users for access to online systems for use in an electronic transaction or communication; smart cards containing programming, namely, digital certificates, used to verify the identity of parties to an electronic transaction" in Class 009; "Digital certification and security services, namely, providing encryption of data; computer consultation in the field of network security and authentication of digital signatures in an electronic transaction or communication; design of computer hardware, software, and specifications used for network security and authentication of digital signatures and identities in an electronic transaction or communication; technical support services, namely, troubleshooting of computer hardware and software problems via telephone, email and in person" in Class 042; and, "Issuance and validation of digital certificates providing authentication of the source of a digital communication, authentication of identity and/or of a digital signature in an electronic transaction or communication, authentication of identity for physical or logical access control" in Class 045. ("532 Registration") The '532 Registration issued September 23, 2008, bears a date of first use of March 31, 2006, and is valid and subsisting.

3. Thus, beginning at least as early as March 31, 2006, IdenTrust has used its IDENTRUST mark in commerce on or in connection with identity authentication software and

services. By virtue of IdenTrust's extensive and continuous usage, coupled with substantial sales in commerce and significant promotional and advertising activities, IdenTrust has achieved widespread recognition with the relevant trade and public of its IDENTRUST mark for identity authentication software and services, creating a substantial and valuable goodwill among the relevant trade and public with respect to its mark.

4. IdenTrust began using the IDENTRUST mark in United States interstate commerce in connection with identity authentication software and services at least as early as March 2006, and applied for the '532 Registration in the United States on February 13, 2006 (granted on September 23, 2008, valid and subsisting). Such use and priority clearly predates Applicant's April 11, 2012, date of application for IDENTOGO. Accordingly, priority is not an issue in this proceeding.

#### **Applicant and its IDENTOGO Designation**

5. On April 11, 2012, Applicant filed its intent-to-use application, Serial No. 85/594,287, for the IDENTOGO designation for use in connection with: "Identification verification services, namely, the issuance and authentication of identification cards, driver's licenses, hunting and fishing licenses, and other identity documents" in class 045.

#### **Likelihood of Confusion**

6. Applicant's intended use of the mark IDENTOGO for the specified services so resembles IdenTrust's IDENTRUST mark as to be likely to create confusion, mistake, or deception under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

7. Applicant's proposed IDENTOGO mark is substantially similar in sound and appearance to IdenTrust's IDENTRUST mark. For example, Applicant and Opposer's marks are conjunctions formed by joining "IDENT" with a short suffix. Consumers encountering the IDENTOGO mark could reasonably believe that identification verification services sold and/or

licensed under or in connection with the IDENTOGO mark are offered by, affiliated with or otherwise sponsored by IdenTrust.

8. Moreover, Applicant's offerings of identification verification services are broadly defined ("identification verification services, namely, ... authentication of ... identity documents") so as to overlap with many of IdenTrust's services, such as "authentication of digital signatures and identities in an electronic transaction or communication" and "authentication of identity and/or of a digital signature in an electronic transaction or communication, authentication of identity for physical or logical access control" (*see also **Exhibit A***), and are closely related to all of IdenTrust's goods and services. There is thus a strong likelihood that Applicant's services could be purchased or licensed by an overlapping class of purchasers and may likely be marketed, promoted, sold and/or licensed in the same trade channels as the identity authentication software and consulting services offered by IdenTrust under its under its IDENTRUST mark.

9. As the application herein opposed has no limitation on trade channels, Applicant's services are presumed to move through all of the ordinary and usual channels of trade for such services and would likely be encountered by the very same consumers who purchase identity authentication software and services offered by IdenTrust under its IDENTRUST mark.

10. Upon information and belief, reasonable opportunity for discovery and investigation will yield evidentiary support for the fact that, at the time Applicant filed its trademark application to register its IDENTOGO mark, Applicant had actual knowledge of the existence of IdenTrust's IDENTRUST mark and the '532 Registration.

11. Upon information and belief, reasonable opportunity for discovery and investigation will yield evidentiary support for the fact that, Applicant adopted and/or intends to

adopt its proposed IDENTOGO mark with the intent to trade off of the goodwill represented by IdenTrust's IDENTRUST mark.

12. IdenTrust has established considerable goodwill in connection with its IDENTRUST mark. Having established such goodwill, IdenTrust is entitled to protection against use of confusingly similar marks.

13. If Applicant's IDENTOGO mark registers, purchasers are likely to believe that Applicant's mark and the products and services offered thereunder originated with or are connected or associated with, or sponsored, licensed, or approved by IdenTrust, all to IdenTrust's detriment. Registration of Applicant's mark would allow Applicant to wrongfully appropriate IdenTrust's valuable goodwill and reputation associated with its IDENTRUST mark.

WHEREFORE, IdenTrust believes that as a result of the likelihood of confusion with Applicant's proposed IDENTOGO mark, IdenTrust will be damaged by registration of the IDENTOGO mark and prays that the TTAB sustain this opposition and refuse to register Application Serial No. 85/594,287.

IdenTrust hereby appoints hereby appoints Brian R. McGinley, Stephen Huggins, Adam C. Rehm, Carol Anne Been and SNR Denton US LLP, P.O. Box #061080, Wacker Drive Station, Willis Tower, Chicago, IL 60606-1080, as its representative upon whom notices and process in proceedings affecting this proceeding may be served.

Respectfully submitted,

SNR DENTON US LLP

Dated: November 20, 2012

By: /Stephen Huggins/  
Stephen J. Huggins  
Brian R. McGinley  
Attorneys for IdenTrust, Inc.  
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**CERTIFICATE OF SERVICE**

I hereby certify that I caused a true and correct copy of the foregoing NOTICE OF  
OPPOSITION to be served upon:

JOHN W. PROVO  
MASLON EDELMAN BORMAN & BRAND, LLP  
90 S 7TH ST STE 3300  
MINNEAPOLIS, MINNESOTA 55402-4104  
UNITED STATES

by placing same in an envelope, properly sealed and addressed, with postage prepaid and  
depositing same with the United States Postal Service on this 20th day of November, 2012.

/stephen j. huggins/  
Stephen Huggins

Filed with the TTAB via  
ESSTA on November 20, 2012

## MorphoTrust™ Transaction Solutions

MorphoTrust Transaction Solutions are designed to simplify and secure transactions where ensuring the identity of the individual is paramount. Wherever a transaction requires verification that a person is who they claim to be, MorphoTrust has the solution.

- We have unparalleled experience in the collection of biometric data including facial and fingerprint solutions for state and local governments
- We have more than 10,000 document authentication systems deployed in mission-critical environments including border control, transportation, departments of motor vehicles and critical infrastructure locations
- Our systems manage the largest databases of fingerprint data in the U.S. via our work with multiple agencies within the federal government
- We are one of a small number of commercial organizations approved and trusted to send transactional fingerprint data directly to the FBI on behalf of the state agencies that regulate trusted professions such as education, transportation, healthcare and commercial transport
- Our self-service solutions uniquely include biometrics as a way of establishing a trusted identity with unmanned kiosks and online-facilitated transactions

Whenever transactions are tied to establishing a trusted identity, while protecting personally identifiable information, only MorphoTrust has the Identity Framework and expertise to deliver complete solutions demanded by government and commercial entities. From simple self-service solutions, to more comprehensive and sophisticated solutions for aviation and commercial ID authentication, MorphoTrust enables trusted transactions.

Examples of our competencies in this area include the following solutions:

- Biometric screening solutions and devices
- Border management solutions and devices
- Self-service and kiosk solutions
- Document authentication, scanning and archiving solutions and devices
- Online/mobile solutions
- Aviation, retail and banking solutions

